

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Patent Application No. 10/530,394

Applicant: Verschueren

Filed: April 4, 2005

TC/AU: 2854

Examiner: Zimmerman, Joshua D.

Docket No.: 234854 (Client Reference No. GSGN02109)

Customer No.: 23460

APPELLANT'S REPLY BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In support of the appeal from the final rejection dated November 1, 2007, Appellant hereby submits his reply brief on appeal.

Argument

After considering the arguments advanced in the Examiner's Answer, Appellant remains firmly convinced that the claims in issue are patentable over the prior art references.

The Examiner's Answer fails to overcome the teaching presented in the prior art. As discussed in detail in Appellant's opening brief, a fair and complete reading of Kamitani and McCullough et al. clearly teaches one skilled in the art to avoid the use of the claimed process. *See, e.g., Appellant's Brief, Section I.*

By way of example, the Examiner's Answer ignores the results achieved when one adjusts the processing temperature upward. Kamitani itself characterizes products resulting from this approach as unsatisfactory: "when the final temperature reached in either the hot air drying device 20 or the far infrared radiation heating device 50 was **140°C or more, the developability**

deteriorated.” When this temperature exceeded **145°C**, the **“developing was poor.”** *See Kamitani ¶ [0087] (emphasis added).* Kamitani indicates that this teaching is supported by the data of Table 1. Table 1 of Kamitani shows that precursors having an exit surface temperature of 142°C had faults with respect to developability and overall quality, while precursors having an exit surface temperature of **153°C** had **unsatisfactory developability and overall quality.** *See Kamitani, Table 1 (entries for 141°C and 152°C)(emphasis added).* Analogous statements are included in McCullough et al., as detailed in Appellant’s Brief.

The Examiner’s Answer has no convincing answer to the actual data which teach one skilled in the art to avoid relatively high processing temperatures, and no convincing answer to the prior art’s own clear and unambiguous characterization of those results as “poor” or “unsatisfactory.” Instead, the Examiner’s Answer chooses to rely on general language which purportedly teaches that is acceptable to identify proper process parameters based on trial-and-error. However, this alleged trial-and-error would not be understood by those skilled in the art to encompass processes which provide products that the reference itself characterizes are less than satisfactory, using the terms “poor” and “unsatisfactory.” This type of analysis—blind to the actual results obtained by a process—cannot render the claims unpatentable, as it fails to consider the reference for all that it teaches. Here, even under the analysis presented in *KSR*, there is simply no reasonable basis to conclude that the prior art renders the claims on appeal unpatentable over the prior art of record. The prior art teaches away from the subject matter of the claims on appeal.

Appellant reasserts but does not repeat herein the other arguments set forth the opening brief relative to the claims on appeal, as those arguments address the points raised by the Examiner in the Examiner’s Answer. *See, e.g., Appellant’s Brief, Section 2 et seq.*

Conclusion

For all of the foregoing reasons, Appellant respectfully requests reversal of the rejections set forth in the Final Office Action dated November 1, 2007.

Respectfully submitted,

October 6, 2008

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